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EXAMINER

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16

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/528,356
Filing Date: March 17, 2000
Appellant(s): NIIKAWA ET AL.

Douglas A. Sorensen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/25/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10, 12-24, 26, and 27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,745,102	BLOCH et al.	4-1998
5,937,107	KAZAMI et al.	8-1999
5,887,198	HOULBERG et al.	3-1999
5,731,861	HATANO et al.	3-1998
5,600,563	CANNON et al.	2-1997
4,200,390	TAGASHIRA et al.	4-1980

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 6, 7, 12-14, 20, 21, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. (5,745,102) in view of Kazami et al. (5,937,107).

Bloch et al. teaches (column 1, line 64 - column 2, line 14; column 3, lines 49-65; and column 4, lines 49-65: figs. 1, 2A, and 2B) of a driving device (figs. 2A and 213, item 210) which accepts a storage medium (fig. 1A, item 120) comprising a memory section to be stored with data and a display section (fig. 1A, item 110) to display information and record data to the memory section, said driving device comprising: a receiving section (fig 2 A, slot for medium not labeled) where the storage medium can be set and ejected, the display section of the storage medium being hidden and not being viewable when the storage medium is set in the receiving section; and a driver which records data to the memory section of the storage medium and renews information displayed on the display section of the storage medium in accordance with the data while the storage medium is set in the receiving section. Bloch also suggests to use large LCD display capable of 640x200 pixels, which can also be used for display games, toys and other consumer products (column 5 lines 45-52) for displaying information such as file name, labeling information, and any other relevant associated information (column 3, lines 32-38, column 10, lines 15-21). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use the device of Bloch to display an image such as a disk volume labeling graphic, or a thumbnail image of the image data as suggests by Bloch so as to provide information

related to the stored data to the user in an intuitive manner. Another reason of doing so is to enable the user using the disk in a graphical user interface system such as Apple Macintosh as suggested by Bloch (see column 3 lines 39-47). Bloch et al. also teaches (column 11, lines 3-22: figs. 2A, 213, 7A, and 713) of an information processing system comprising: a storage medium (fig. 2A and 213, item 120) which has a memory section to be stored with data and a display section to display information; and an information processing device (fig. 7A, item 712) where the storage medium is set to be accessed by the information processing device and can be ejected, the display section of the storage medium being hidden and not being viewable while the storage medium is set in the information processing device; wherein the information processing device comprises: a data processing unit (fig. 7A, item 720 or fig. 713, item 754) which processes data; and a driver which records data processed by the data processing unit to the memory section of the storage medium and renews information on the display section of the storage medium in accordance with the data as recited in claim 6. In regard to claims 2, 7, and 21, Bloch et al. teaches (column 3, lines 49-65; fig. 1A) of a power supply section (fig. 1A, item 116) which supplies electric power to the display section (fig. 1A, item 110) of the storage medium so that the driver can renew information on the display section. Bloch et al. do not expressly teach that the driver records image data to the memory section and writes a thumbnail image of the image data on the display section.

Kazami et al. teaches (column 2, lines 49-63; fig. 1) that the driver records image data to the memory section (fig. 1, item 37) and writes a thumbnail image of the image

data on the display section (fig. 1, items 28 and 29). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store images in memory and display them on a display. One of ordinary skill in the art would have been motivated to do this because it would have provided a way of looking at several images at once which is what Kazami et al. intended, and displaying thumbnail image instead of the file name in the memory disk obviously provides more information about the files being stored to the user, but would require a bigger display section and slow down the operation of the system. Furthermore, at the time the invention was made, it would also have been obvious to a person of ordinary skill in the art that the processor having the ability to store images in memory would also have had the ability to delete the images from memory, as it would have been able to do with any other type data. Furthermore, at the time the invention was made, it would also have been obvious to a person of ordinary skill in the art that a camcorder (as recited in claims 12 and 26) could have been used with the device of Bloch et al., thereby providing a means to input image data.

4. Claims 3-5, 8-10, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. (5,745,102) and Kazami et al. (5,937,107) as applied to claims 1, 2, 6, 12-14, 20, 21 above, and further in view of Hatano et al. (5,731,861).

In regard to claims 3-5, 8-10, and 22-24, Bloch et al. does not expressly teach that the display section uses a material with a memory effect nor that the material is liquid crystal which exhibits a cholesteric phase at a room temperature. Hatano et al. teaches (column 6, lines 12-28; fig. 1) that the display section uses a material with a

memory effect (fig. 1, item 3) and that the material is liquid crystal (fig. 1, item 3a) which exhibits a cholesteric phase at a room temperature. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a display that utilized a material with memory effect of. One of ordinary skill in the art would have been motivated to do this because for several reasons: no power would have had to be drawn from the power supply (fig. 1, item 116) in the display section of Bloch et al. unless the contents of the display was actually going to be changed, it would have made it possible for the drive circuitry (fig. 1A, item 114) not to contain memory thereby simplifying that circuit, and the power supply wouldn't even have needed to resided with the display section since power could then have been supplied through item 112 of fig. 1A when it was needed. It is also well known in the art that the property of the liquid crystals to possess bi-stable states is a property of cholesteric phase and this is also well known to occur at room temperature.

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. (5,745,102) and Kazami et al. (5,937,107) as applied to claims 1, 2, 6, 7, 12-14, 20, and 21 above, and further in view of Houlberg et al. (5,887,198).

In regard to claims 15 and 16, Bloch et al. as modified does not teach that the driver performs formatting of the memory section nor that the driver changes information on the display section in accordance with a format to a piece of information indicating format. Houlberg et al. teaches (column 2, lines 18-21) that the driver performs formatting of the memory section. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to format the memory section. One

of ordinary skill in the art would have been motivated to do this because it is a common practice to format memory in a device so as to except the data in a particular form easily. At the time the invention was made, it would also have been obvious to a person of ordinary skill in the art that in formatting memory, one is usually given an indication on the display that this has occurred.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. (5,745,102) and Kazami et al. (5,937,107) as applied to claims 6 above, and further in view of Cannon et al. (5,600,563).

In regard to claim 17, Bloch et al. does not expressly teach that the processing device is a printer. Cannon et al. teaches (column 2, line 65- column 3, line 12) that the processing device is a printer. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art that there were printers then that did contain processing systems that could read removable data storage devices and both display and print the contents thereof.

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. (5,745,102), Kazami et al. (5,937,107), and Cannon et al. (5,600,563) as applied to claim 17 above, and further in view of Tagashira et al. (4,200,390).

In regard to claims 18 and 19, Bloch et al. and Cannon et al. together do not expressly teach that the driver renews information displayed on the display section about a number of prints on completion of printing. Tagashira et al. teaches (column 11, lines 7-19; figs. 1 and 2) teach that the driver renews information displayed on the display section (fig.2, item 101 a) about a number of prints on completion of printing. At

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the time the invention was made, it would have been obvious to a person of ordinary skill in the art that there were printers then that did have displays on them that displayed information about the number of prints printed upon completion of printing.

(11) Response to Argument

Appellant mainly argues that the display in the device of Bloch can not be used for displaying a graphical image, and one skilled in the art would not be motivated to try to display the images on the display of Bloch (the same argument was repeated in the argument of every grouping of the claims). However, Bloch teaches to use large LCD display capable of 640x200 pixels, which can also be used for display **games, toys** and other consumer products (column 5 lines 45-52) for displaying information such as file name, labeling information, and any other relevant associated information (column 3, lines 32-38, column 10, lines 15-21). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use the device of Bloch to display an image such as a disk volume labeling graphic, or a thumbnail image of the image data as suggests by Bloch so as to provide information related to the stored data to the user in an intuitive manner. Another reason of doing so is to enable the user using the disk in a graphical user interface system such as Apple Macintosh as suggested by Bloch (see column 3 lines 39-47).

Furthermore, the display in the device of Kazami are also capable of displaying graphical images such as thumbnail image. Appellant should note that one cannot show nonobviousness by attacking references individually where the rejections are

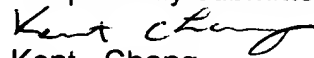
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based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the reference of Bloch alone or in combination with the reference of Kazami have suggested to display graphical images such as a disk volume labeling graphic, or a thumbnail image of the image data.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Kent Chang

Primary Examiner

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kc

February 22, 2004

Conferees

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